

## **REMARKS**

The Examiner, in the Official Action, has rejected claims 1-3, 5 and 7 under 35 USC § 103(a) as being unpatentable over Brugada in view of Guerra et al. for the reasons set forth in paragraph 3.

The present invention, as currently set forth in independent claim 1, is directed to a method of making a continuous tone image that includes the step for making at least one micro discrete continuous tone image on a photosensitive media wherein the discrete continuous tone image is formed on a photosensitive media capable of producing a continuous tone image using near field optics, the continuous tone image being less than about 0.015 mm. Claim 5 is similar to claim 1 wherein the continuous tone image formed on the media produces images no larger than 20 microns. Claim 7 is the last independent claim directed to a product having a plurality of micro discrete tone images placed thereon by near field optics wherein the continuous tone image has a size no greater than about 20 microns.

Applicants respectfully submit that the Brugada reference is not relevant to the present invention. In particular, the Brugada reference discloses the providing of security micro pattern to prevent falsification of documents printed on a support. Furthermore, the Brugada reference could not have anticipated the full performance of providing micro discrete continuous tone images enabled by near field optics as claimed by Applicants because the physics of the image formation mechanism is entirely different for near field optics as opposed to classical optics. The resolution image formed by near field optics technology was not anticipated by classical optics where the resolution is limited by physical diffraction theory. Near field optics allow formation of images with resolution that far exceed the limits of optical systems where the diffraction determines the resolution performance limit. Another distinct feature of the present invention is that Applicants invention is directed to providing a continuous tone images whereas Guerra et al. describes the writing of spot which is either there or not.

While the Guerra reference is directed to near field optics, there is no teaching or suggestion of providing the invention as taught and claimed by Applicants. Further, there is no teaching or suggestion or motivation to combine Guerra with Brugada, the essential factual evidence on the issue of obviousness as set forth in *Graham v. John Deer*. When patentability turns on the question of obviousness, the search for an analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation or suggestion to select the reference relied on as evidence of obviousness. There must be objective evidence

to combine the reference. See *in re Lee* 61 USPQ2d at page 1433. The showing of a suggestion, teaching or motivation to combine the prior art references is an essential component of an obviousness holding. There must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicants. There must be an explanation for the reasons why one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. There is no suggestion or motivation for combining Guerra and Brugada references. They are directed to two totally different technologies.

Accordingly, Applicants respectfully submit that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Frank Pincelli', written over a horizontal line.

Attorney for Applicant(s)  
Registration No. 27,370

Frank Pincelli/phw  
Rochester, NY 14650  
Telephone: 585-588-2728  
Facsimile: 585-477-4646